REMARKS

Claims 1-4, 6-18 and 21 are pending in this application. Claims 1, 9, 10, 18, and 21 have been amended herein. Claim 5 is cancelled herein without prejudice or disclaimer. Support for the amendments to the claims may be found in claim 5 as originally filed, in the specification at page 9, lines 22 to 25 and page 13, line 24 to page 15, line 3, and in Figs. 1, 3, and 4. Reconsideration is requested based on the foregoing amendment and the following remarks.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments, and the new grounds of rejection. Further reconsideration is thus requested.

Claim Rejections - 35 U.S.C. § 103:

Claims 1, 3, 7-10, 12, 14, 16-18 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,787,402 to Potter et al. (hereinafter "Potter") in view of Dian Hymer, "Starting Out The Complete Home Buyer's Guide," Chronicle Books, San Francisco, 1997 (hereinafter "Hymer") and CyBerCorp, "Trader's Workstation and Integrated Trading Environment version 1.7" dated 10/1998 (hereinafter "CyBerCorp"). The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

The claimed "first movable goods" and "second movable goods" are separate goods, and their transaction prices are substantially separately determined. In the claimed invention, however, the price of the "first movable goods" included in a chain order is changed automatically when the price of the "second movable goods" is changed. That is, the prices of the "first movable goods" and the "second movable goods" are changed in an interlocked manner, allowing a person ordering the goods to secure a profit. The fifth clause of claim 1, in particular, recites:

> Responsive to a change in price of the second movable goods, automatically
> changing a price of the corresponding first movable goods of the chain order in
> an interlocked manner.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner," as recited in claim 1. In Potter, rather, the trader may need to *communicate* with another individual at the "interbank" desk in order to determine the price. In particular, as described at column 2, lines 21 to 30:

The trader will take down the information and then determine the price to the customer by assessing several factors including, the current "wholesale" rate of exchange between the currencies, the nature of the customer and the size of the transaction. In order to determine the price, the trader may need to communicate with another individual at the "interbank" desk. The "interbank" desk is the desk affiliated with the bank which determines the base exchange rates to which the bank will commit.

Since, in Potter, the trader may need to communicate with another individual at the "interbank" desk in order to determine the price, Potter is not "responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner," as recited in claim 1.

Neither Hymer nor CyBerCorp mention "responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner," at all, and thus cannot make up for the deficiencies of Potter with respect to claim 1.

In addition, the second clause of claim 1 recites:

A chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B.

Potter neither teaches, discloses, or suggests a chain order, as recited in claim 1. Potter, rather, allows a *single* client to link several of his or her *own* orders together. In particular, as described in Potter at column 14, lines 54-63:

FX Order Strategies allow orders to be linked to other orders under certain conditions. The Order Blotter indicates orders' Strategies, if any. This includes: allowing an Active order to be set to another order to Cancel if the Active order is Done (OCO); setting an Active order to execute only if another designated Active order executes (IF/THEN); selecting orders for placement in loops so that orders effect each other in different ways depending on each selected order's individual state (LOOP); and selecting a group of orders and assigning specific states to each order (OCORE).

Claim 1, in contrast, recites a "chain order," in which, in particular, "on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B."

The fourth clause of claim 1 recites:

Performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B.

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Potter neither teaches, discloses, or suggests a chain order, as discussed above, let alone "performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B," as recited in claim 1.

The Office Action seeks to make up for these deficiencies of Potter by combining Potter with Hymer and CyBerCorp, saying in the last paragraph at page 3, continuing at page 4:

> However, Hymer discloses performing a purchasing or selling process with respect to the second foreign currency (movable goods) by said customer B [see selected pages of chapter 8] where a purchasing order of a new house/property is conditioned on the sale of the old house (property) to get use the equity of the old house for the down payment of the new house and CyBerCorp discloses condition chain order and execution of the order based on another order (particularly page 32 – Alert Box – where a logical script shows that a trade can be made using computer script) to provide computer script for execution of conditional orders.

Potter, however, teaches away from chain orders by warning that the customer must not be permitted to purposefully postpone commitment to an offer until after the market has moved and then, if the movement is to the customer's advantage, accept the offer. This is exactly what a contingent sale, such as a chain order, attempts to do: purposefully postpone commitment to an offer until after the market has moved, i.e. the contingent sale has taken place. In particular, as described in Potter at column 2, lines 59-64:

> In a similar vein, whatever system is used must require that the customer commit quickly to the bank's offer. The customer must not be permitted to purposefully postpone commitment to an offer until after the market has moved and then, if the movement is to the customer's advantage, accept the offer.

It is submitted, therefore, that persons of ordinary skill in the art would not have been motivated to modify Potter to arrive at the claimed invention, because Potter warns against permitting a customer to purposefully postpone commitment to an offer until after the market has moved.

In addition, even if Potter could be modified to arrive at the claimed invention, neither Hymer nor CyBerCorp could make up for its deficiencies with respect to the claimed invention, since Hymer and CyBerCorp, as pieces of literature, would not have been enabling. In particular, to serve as an anticipating reference, Hymer and CyBerCorp must enable one of skill in the art to make and use the claimed invention.

> "A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). See Bristol-Myers Squibb v. Ben Venue Laboratories, Inc., 246

F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001) ("To anticipate the reference must also enable one of skill in the art to make and use the claimed invention."); PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."). Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373 (CAFC 2003).

Since Hymer merely mentions contingent offers, but does not teach persons of skill in the art how to perform "a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B," as recited in claim 1, Hymer cannot be enabling within the provisions of 35 U.S.C. § 112, first paragraph. Since Hymer cannot enable chain orders, Hymer cannot anticipate chain orders. Thus, Hymer shows no chain order either, and so even if Potter and Hymer were combined as proposed in the Office Action, the claimed invention would not result.

CyBerCorp, similarly, shows no chain order at all, contrary to the assertion of the Office Action, let alone enables a person of ordinary skill in the art to make and use a chain order. The Alert Box at page 32, in particular, merely shows a completed trade being reported. The Alert Box, in fact, shows only one transaction, 1000 shares of Dell stock being bought at market, and thus cannot be a chain order in any case. Thus, even if Hymer and CyBerCorp were combined with Potter, the claimed invention would not result.

Finally, M.P.E.P. § 2143.01 prohibits a proposed modification that renders a reference unsatisfactory for its intended purpose. As provided therein:

> If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The purpose of Potter is to perform automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution. There is no place for chain orders in transactions involving only a customer and a financial institution, since there is no second customer upon whose purchase or sale the first customer's activities might be made to depend. In particular, as described in Potter at column 1, lines 9-14:

> The present invention relates generally to methods and systems for performing automated financial transactions, and more particularly to a method and system for performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution.

Since there is no place for chain orders in transactions involving only a customer and a financial institution, and the purpose of Potter is to perform transactions involving only a customer and a financial institution, modifying Potter as proposed in the Office Action would have rendered potter unsatisfactory for its intended purpose. Since the modification proposed in the Office Action would have rendered Potter unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification, *In re Gordon*. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 2, 3, 7, and 8 depend from claim 1 and add additional distinguishing elements. Claims 2, 3, 7, and 8 are thus also submitted to be allowable. Withdrawal of the rejection of claims 2, 3, 7, and 8 is earnestly solicited.

Claim 9:

The third clause of claim 9 recites:

Permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B," as discussed above with respect to the rejection of claim 1.

The fifth clause of claim 9 recites:

Responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B," as discussed above with respect to the rejection of claim 1, either.

The sixth clause of claim 9 recites:

Responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner," as discussed above with respect to the rejection of claim 1, either. Thus, even if Hymer and CyBerCorp were combined with Potter, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art who read Potter for all it contained at the time the invention was made would have been deterred from modifying Potter as proposed in the Office Action, as also discussed above with respect to the rejection of claim 1.

Finally, the modification of Potter proposed by the Office Action renders Potter unsatisfactory for its intended purpose of performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution, and ought to be withdrawn, as also discussed above with respect to the rejection of claim 1. Claim 9 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 9 is earnestly solicited.

<u>Claims 10, 11, 12, 14, 16, and 17:</u>

The second clause of claim10 recites:

Permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B," as discussed above with respect to the rejection of claim 1.

The fourth clause of claim 10 recites:

Responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B," as

discussed above with respect to the rejection of claim 1, either.

The fifth clause of claim 10 recites:

Responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner," as discussed above with respect to the rejection of claim 1, either. Thus, even if Hymer and CyBerCorp were combined with Potter, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art who read Potter for all it contained at the time the invention was made would have been deterred from modifying Potter as proposed in the Office Action, as also discussed above with respect to the rejection of claim 1.

Finally, the modification of Potter proposed by the Office Action renders Potter unsatisfactory for its intended purpose of performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution, and ought to be withdrawn, as also discussed above with respect to the rejection of claim 1. Claim 10 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 10 is earnestly solicited.

Claims 11, 12, 14, 16, and 17 depend from claim 10 and add additional distinguishing elements. Claims 11, 12, 14, 16, and 17 are thus also submitted to be allowable. Withdrawal of the rejection of claims 11, 12, 14, 16, and 17 is earnestly solicited.

Claim 18:

The second clause of claim 18 recites:

Permitting the input of a chain order, the chain order being an order requesting, on condition of execution of an order for sale of the first movable goods by customer A, purchase of a second movable goods by customer B from a third party, the second movable goods being different from the first movable goods.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "permitting the input of a chain order, the chain order being an order requesting, on condition of execution of an order for sale of the first movable goods by customer A, purchase of a second movable goods by customer B from a third party, the second movable goods being different from the first movable goods," as discussed above with respect to the rejection of claim 1.

The fourth clause of claim 18 recites:

> A chain order processor, responsive to the detection of said sell order for the first movable goods by said order detecting unit, automatically executing the chain order by purchasing the second movable goods by said customer B.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "a chain order processor, responsive to the detection of said sell order for the first movable goods by said order detecting unit, automatically executing the chain order by purchasing the second movable goods by said customer B," as discussed above with respect to the rejection of claim 1, either.

The fifth clause of claim 18 recites:

> A price changer for, responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "a price changer for, responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner," as discussed above with respect to the rejection of claim 1, either. Thus, even if Hymer and CyBerCorp were combined with Potter, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art who read Potter for all it contained at the time the invention was made would have been deterred from modifying Potter as proposed in the Office Action, as also discussed above with respect to the rejection of claim 1.

Finally, the modification of Potter proposed by the Office Action renders Potter unsatisfactory for its intended purpose of performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution, and ought to be withdrawn, as also discussed above with respect to the rejection of claim 1. Claim 18 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 18 is earnestly solicited.

Claim 21:

The second clause of claim 21 recites,

> permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "permitting input of a chain

order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B," as discussed above with respect to the rejection of claim 1.

The fourth clause of claim 21 recites:

Responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B," as discussed above with respect to the rejection of claim 1, either.

The fifth clause of claim 21 recites:

Price changing means for, responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner.

Neither Potter, Hymer, nor CyBerCorp teach, disclose, or suggest "price changing means for, responsive to a change in price of the second movable goods, automatically changing a price of the corresponding first movable goods of the chain order in an interlocked manner," as discussed above with respect to the rejection of claim 1, either. Thus, even if Hymer and CyBerCorp were combined with Potter, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art who read Potter for all it contained at the time the invention was made would have been deterred from modifying Potter as proposed in the Office Action, as also discussed above with respect to the rejection of claim 1.

Finally, the modification of Potter proposed by the Office Action renders Potter unsatisfactory for its intended purpose of performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution, and ought to be withdrawn, as also discussed above with respect to the rejection of claim 1. Claim 21 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 21 is earnestly solicited.

Claims 4, 6, 13, and 15:

Claims 4, 6, 13, and 15 were rejected under 35 U.S.C. § 103 as being unpatentable over

Potter and Hymer, and further in view of Nymeyer, US 3,581,072 (hereinafter "Nymeyer"). The rejection is traversed. Reconsideration is earnestly solicited.

Claims 4, 6, 13, and 15 depend from claims 1 or 10 and add additional distinguishing elements. Neither Potter nor Hymer teach, disclose, or suggest a chain order, as discussed above with respect to the rejection of claim 1. Nymeyer does not either, and thus cannot make up for the deficiencies of either Potter or Hymer with respect to claims 4, 6, 13, and 15. Thus, even if Potter, Hymer, and Nymeyer were combined as proposed in the Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art who read Potter for all it contained at the time the invention was made would have been deterred from modifying Potter as proposed in the Office Action, as also discussed above with respect to the rejection of claim 1.

Finally, the modification of Potter proposed by the Office Action renders Potter unsatisfactory for its intended purpose of deferring adverse tax consequences and the creation of taxable events, and ought to be withdrawn, as also discussed above with respect to the rejection of claim 1. Claims 4, 6, 13, and 15 are submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claims 4, 6, 13, and 15 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-4, 6-18 and 21 are allowable over the cited references. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.
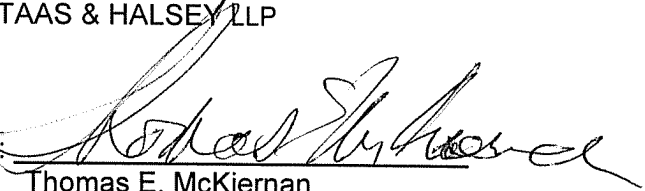
If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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